



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110

MAILED
SEP 27 2011
OFFICE OF PETITIONS

Patent No. 6,410,271 :
Issued: June 25, 2002 :
Application No. 09/602,373 : ON PETITION
Filed: June 23, 2000 :
Attorney Docket No. 2009186-0026 :

This is in response to the petitions filed July 5, 2011 under 37 CFR 1.59, to expunge information from the file of the above identified patent, and under 37 CFR 1.183, to waive the consideration of 37 CFR 1.59 as it applies to application files such that the identified information may be expunged from the patent file. This is also a decision on the submission under 37 CFR 1.217(d) to redact the information in the event that it is not expunged.

The petitions under 37 CFR §§ 1.59 and 1.183 of 1.59 are **dismissed**, and the request to redact is **dismissed**.

In regard to the petition under 37 CFR 1.59, 37 CFR 1.59 states in part:

- (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
- (2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.
- (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and **establish to the satisfaction of the Director that the expungement of the information is appropriate** in which case a notice granting the petition for expungement will be provided. [emphasis added]

The petition requests that information submitted in the patent file be expunged as information that should have been submitted under MPEP 724.02 or, alternatively, as information that was unintentionally submitted.

The standards for expunging information that was, or should have been, submitted in an application under MPEP section 724.02, including the standards for establishing that the

expungement of the information is appropriate, is discussed in MPEP section 724.05 I. This section states that a petition may be filed under 37 CFR 1.59(b), provided that:

- (A) a clear identification of the information to be expunged is provided without disclosure of the details thereof;
- (B) a clear statement is made that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
- (C) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (D) a statement is made that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
- (E) the petition fee as set forth in 37 CFR 1.17(g) is included.

The standards for expunging information that is unintentionally submitted in an application, including the standards for establishing that the expungement of the information is appropriate, is discussed in MPEP section 724.05 II. This section states that a petition may be filed under 37 CFR 1.59(b), provided that:

- (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(g) is included.

As the petition recognizes, 37 CFR 1.59 relates to application files and, since this file is a patented file, the information may not be expunged under 37 CFR 1.59. Also, the petition does not satisfy item (B) set forth in MPEP 724.05 I or item (C) set forth in MPEP 724.05 II. The petition does state that "the information...is proprietary material." However, there is no statement that the information has not been otherwise made public. Petitioners should note that publicly available information, such as identifying information on a patented or published file and parent applications to which priority is claimed, is information that has been made public.

In regard to the requested waiver of 37 CFR 1.59, 37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party,

subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

The consideration of 37 CFR 1.59 as it applies to application files is not a requirement of the regulations that may be waived. The patent statute gives the USPTO limited authority over patents and their related files, such as in proceedings for reissue or re-examination of a patent. Authority over patents is generally reserved for the courts. Currently, none of the regulations provide for the requested waiver. Moreover, the petition does not present an extraordinary situation that would justify the waiver. While the petition does state that "the information...is proprietary material," the information includes publically available information, such as identifying information on a patented or published file and parent applications to which a patented files claim priority. Accordingly, the requested waiver is dismissed.

In regard to the request to redact the information under 37 CFR 1.217(d), that regulation is limited to application files and is not applicable to patented files. In addition, the consideration of this regulation as it applies to application files is not a requirement of the regulations that may be waived, similar to the discussion presented above in relation to 37 CFR 1.59.


Furthermore, as for the request that the petitions and petition decision be expunged to prevent public notification of both the existence and location of the proprietary information, it is the policy of the USPTO to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Office procedures for expunging a document serve to protect trade secrets, proprietary material, and protective order material, but are not available to suppress knowledge of the existence or location of expungement proceedings. Communications related to the requested expungement, which do not include trade secrets, proprietary material, and protective order material, are included in the record to ensure as complete a patent file wrapper as possible. Since this decision does not provide specific proprietary information, it will immediately be made of record in the file of the above identified application.

The petition additionally contends that if the information had been submitted in a sealed envelope in the filing of May 16, 2011, it would have been accompanied by a Petition under 37 CFR 1.59 to expunge information submitted under MPEP 724.02. However, this hypothetical scenario assumes that such a petition under 37 CFR 1.59 would have been granted. This assumption is not correct as trade secret, confidential, and proprietary material are open to the public upon issuance of the application in the event the petition under 37 CFR 1.59 is denied. See MPEP 724.04.

If a renewed petition is filed, petitioner is cautioned to avoid submitting personal information in documents filed that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such

personal information from the documents before submitting them to the USPTO. Petitioner is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Petitioner is further reminded of the two (2) month, non-extendable, period to file such a renewed petition, as established in 37 CFR 1.181(f).

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-6692.

A handwritten signature in black ink, appearing to read "Christopher Bottorff", is written above the printed name.

Christopher Bottorff
Petitions Examiner
Office of Petitions